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RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURES EXAMINING
GROUP 2643

PATENT
0630-1273P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant:	Paul JEON et al.	Conf.:	6735
Appl. No.:	09/880,857	Group:	2643
Filed:	June 15, 2001	Examiner:	G. Eng
For:	NETWORK INFRASTRUCTURE INTEGRATED SYSTEM		

PETITION UNDER 37 CFR §1.181

Commissioner for Patents   October 6, 2004
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully petition the decision of the Examiner, as set forth in

the August 19, 2004 Advisory Action, denying entry of the Amendment filed under

37 CFR §1.116 for purposes of Appeal.

Initially, Applicants note that this Petition is filed under 37 CFR §1.181

and does not require any fee.

BACKGROUND

Applicants filed an Amendment on July 12, 2004 that amended claim 1 to include features from claims 2 and 6, which features were previously searched and examined.

In particular, claim 2 was amended by the July 12, 2004 Amendment by removing the following language: "telephone line network includes phone line networking alliance (PNA) modems, the power line network includes PNA modems each having a coupler for connecting to a power line."

In the July 12, 2004 Amendment, this language was added to claim 1.

Further, claim 6 was amended by deleting the following network bridge features, i.e., "an input protection means for protecting internal circuitry thereof and removing unwanted electric components of the data signal flowing between the telephone line network and the power line network, a matching means connected to the input means and matching impedance of the data signal to an impedance value of the phone line networking alliance (PNA) modems."

In the July 12, 2004 Amendment, this language was also added to claim 1.

The July 12, 2004 Amendment clearly stated that claim 1 was amended to incorporate certain features of previously presented claims 2 and 6.

In the July 12, 2004 Amendment, Applicants contended that the claimed subject matter had already been considered on its merits and the amended claims did not present any issues that would require further consideration and/or search.

ARGUMENT

The subject matter added to claim 1 from claims 2 and 6 clearly does not require any further search. It was already searched in connection with the examination of claims 2 and 6.

Applicants also respectfully submit that the subject matter added to claim 1 from claims 2 and 6 does not require further consideration than is normally required when preparing an Examiner's Answer.

Claim 1 was rejected under 35 USC §102(b) as anticipated by certain art disclosed in Applicant's specification.

Claim 2 (from which the aforementioned subject matter was taken and placed into claim 1) was rejected under 35 USC §103 as unpatentable over the aforementioned certain art disclosed in Applicants' specification in view of U.S. Patent 6,107,912 to Bullock.

Claim 6 (from which the aforementioned subject matter was taken and placed into claim 1) was rejected under 35 USC §103 as unpatentable over the aforementioned certain art disclosed in Applicants' specification in view of U.S. Patent 6,040,759 to Sanderson.

It is clear that the same primary reference (certain subject matter disclosed in Applicants' specification) served as the basis for the rejection of claims 1, 2 and 6.

It is also clear that the secondary reference applied in the rejection of claim 2 was used to modify the primary reference to reject the additional subject matter of claim 2, which has now been incorporated into claim 1.

It is also clear that the secondary reference applied in the rejection of claim 6 was used to modify the primary reference to reject the additional subject matter of claim 6, which has now been added to claim 1.

It is clear from an analysis of the rejections that the different secondary references (Bullock regarding claim 2 and Sanderson regarding claim 6) were applied in a straightforward manner to modify different features of the primary reference, and would be applied in the same manner to the rejection of amended claim 1 with those features.

For example, Bullock was applied in the rejection of claim 2 to modify the base reference to provide a power line network including PNA modems each having a coupler for connecting to the powerline – see page 4, paragraph number 6 of the February 11, 2004 Office Action.

Moreover, Sanderson was applied in the rejection of claim 6 to modify the same base reference to include input protection means for protecting internal circuitry and removing unwanted electrical components of data signal flowing through the router, and matching means connected to the input means for matching impedance of the data signal and output means connected to the matching means for filtering data – see page 5, paragraph No. 7 of the February 11, 2004 Office Action.

Any rejection of amended claim 1 would apply the same references in the same manner, as was done in the outstanding rejections of claims 1, 2 and 6

because the secondary references were applied merely to provide cumulative features to the same primary reference.

Furthermore, application of the secondary reference Nelson in the rejection of claim 13 will be for the same reason and in the same manner that Nelson was applied to the primary reference in the rejection of claim 13 in the rejection dated February 11, 2004.

Accordingly, entry of the July 12, 2004 Amendment would not require further consideration.

Thus, the statement in the Advisory Action that the Amendment will not be entered upon the filing of an appeal because it would require further consideration and/or search is incorrect and is not a proper reason for denying entry of the July 12, 2004 Amendment.

Moreover, the remarks attached to the Advisory Action do not present any reasoning in support of the conclusion that entry of the amendment for purposes of an appeal would require further consideration and/or search, thereby denying Applicants fundamental substantive and procedural due process as required under the Administrative Procedures Act. See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Rather, the comments attached to the Advisory Action only address an issue raised with respect to the merits of the rejection, which is an issue that is proper to be considered on appeal.

Applicants respectfully submit that this petition seeks only to enter the Amendment for purposes of Appeal and will address the merits of the Amended claims in a Brief on Appeal.

CONCLUSION

Applicants respectfully submit that entry of the July 12 Amendment is proper because it does not require further consideration and/or search and will permit expeditious prosecution of this Application by permitting Applicants to promptly file a Brief on Appeal to resolve the merits of the patentability issues which have already been raised and fully addressed by Applicants and the Examiner and which will not change due to the entry of this Amendment.

Applicants also submit that the Advisory Action does not provide them with substantive and procedural due process because it does not present any reasoning in support of the conclusion that entry of the amendment will require further consideration and/or search, and merely addresses an issue related to the merits of the rejection, which is properly considered on appeal.

Applicants respectfully request that the decision of the Examiner refusing entry of the July 12, 2004 Amendment be reversed and that the Examiner be ordered to enter the July 12, 2004 Amendment for purposes of Appeal.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future papers, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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